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In re Application of :  
BURCHARDT, Elmer ET AL. :  
Application No.: 09/701,313 :  
PCT Application No.: PCT/EP99/03392 : DECISION ON  
International Filing Date: 17 May 1999 :  
Priority Date: 28 May 1998 : PETITION  
Attorney Docket No.: Le A 32 701 :  
For: MONOCLONAL ANTIBODY : UNDER 37 CFR 1.137(b)  
AND ASSAY FOR DETECTING :  
PIIINP :  
:

Applicants' "Petition For Revival of an International Application For Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office on 03 December 2002, is GRANTED.

#### BACKGROUND

On 17 May 1999, applicants filed international application number PCT/EP99/03392, claiming priority to an earlier European application, filed on 28 May 1998. A copy of the international application was transmitted by the International Bureau to the United States Patent and Trademark Office on 02 December 1999. A demand was filed electing the United States of America on 19 November 1999. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 November 2000.

On 28 November 2000, applicants timely filed national stage papers in this application, including, *inter alia*, the basic national fee and executed inventor declaration. The transmitted international application included applicants' Sequence Listing in paper form.

On 30 April 2001, applicants were mailed a Notification of Missing Requirements FORM PCT/DO/EO/905, with attached Notification to Comply With Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures FORM PCT/DO/EO/920, for failure to provide a CRF Sequence Listing and accompanying statement of identical disclosure and no new matter. Applicants were given a two-month extendible time period of response.

On 18 May 2001, applicants timely filed a paper form Sequence Listing, CRF Sequence Listing, and statement.

On 06 December 2001, applicants were mailed a letter withdrawing a Notice of Acceptance that had been purportedly mailed on 24 October 2001. Since no Notice of Acceptance had been mailed to applicants, this withdrawal notice of 06 December 2001 was moot.

On 06 December 2001, applicants were mailed a Notification of Missing Requirements, with a two-month extendible time for response, and a Raw Sequence Listing Error Report, generated by analyzing the CRF submitted on 18 May 2001.

On 15 February 2002, applicants' paper form Sequence Listing, CRF Sequence Listing, and statement in response to the 06 December 2001 Notification of Missing Requirements were timely filed within the provided two-month period of response.

In the meantime, on 01 February 2002, applicants were mailed a Notification of Defective Response, with a one-month period of response, and a Raw Sequence Listing Error Report, generated by analyzing the CRF submitted on 18 May 2001. This 01 February 2002 Notification was duplicative of the 06 December 2001 Notification except for the 01 February 2002 mailing date, different period of response, and different title. This 01 February 2002 Notification did not account for applicants' 15 February 2002 response.

On 11 March 2002, applicants' paper form Sequence Listing, CRF Sequence Listing, and statement in response to the 01 February 2001 Notification of Defective Response were timely filed within the provided one-month period of response.

On 03 April 2002, applicants were mailed a Notification of Defective Response and CRF Problem Report, explaining that the CRF filed on 15 February 2002 was damaged.

On 20 May 2002, applicants' paper form Sequence Listing, CRF Sequence Listing, and statement in response to the 03 April 2002 Notification of Defective Response were timely filed within the provided one-month period of response.

On 15 August 2002, applicants were mailed a Notification of Abandonment FORM PCT/DO/EO/909 for failure to provide a compliant Sequence Listing in response to the Notification of Missing Requirements mailed on 30 April 2001. Accompanying the Notification of Abandonment was a Raw Sequence Listing Error Report, generated by analyzing the CRF filed on 11 March 2002. Errors not previously identified in the Error Report generated by analyzing the CRF submitted on 18 May 2001 were pointed out to applicants. The CRF, filed on 20 May 2002, was also reported as damaged.

On 03 December 2002, applicants filed this instant petition for revival of an unintentionally abandoned application. On 02 December 2002, applicants paper form Sequence Listing, CRF Sequence Listing, and statement, addressing the Raw Sequence Error Report of the CRF submitted by mail on 01 March 2002, were filed. The CRF filed on 02 December 2002 has been deemed technically acceptable.

## DISCUSSION

### NOTIFICATION OF ABANDONMENT

As assessed on 06 December 2001 and as evidenced by the Raw Sequence Listing Error Report, generated on 05 July 2001 by analyzing the CRF filed on 18 May 2001, applicants' response of 18 May 2001 was noncompliant. Having been issued the Notification of Missing Requirements FORM PCT/DO/EO/905 mailed on 30 April 2001, applicants were obligated to provide a compliant Sequence Listing within the time period for response set forth in that Notification, a maximum of seven months from the mailing date of the Notification. Since applicants response on 18 May 2001 fell within the provided period of response to the Notification of Missing Requirements mailed on 30 April 2001 and since applicants had not already been issued a Notification of Defective Response, applicants, as of 06 December 2001, were entitled to a Notification of Defective Response FORM PCT/DO/EO/916, with a one-month non-extendible time period for response, to enable applicants another opportunity to provide a compliant Sequence Listing. Instead, applicants were improperly given a two-month extendible period of response under a new Notification of Missing Requirements mailed on 06 December 2001.

Applicants responded with noncompliant materials timely filed on 15 February 2002. Applicants' lateness of submission, beyond what should have been a one-month due date, is excused in view of the provision of a two-month extendible period of response in the Notification of Missing Requirements mailed on 06 December 2001. However, by this response filed on 15 February 2002, applicants failed to provide a compliant paper form and CRF Sequence Listing and accompanying statement, within the time period for response set forth in the Notification of Missing Requirements FORM PCT/DO/EO/905 (871 Formalities Notice), mailed on 30 April 2001. This failure is evidenced by the Notification of Defective Response, mailed on 03 April 2002, accompanying which is the CRF Problem Report that describes the CRF filed on 15 February 2002 as damaged.

Due to this failure to provide a compliant response by 30 November 2001, the application went abandoned as of this date. The Notifications of Defective Response mailed on 01 February 2002 and 03 April 2002 were issued in error. It is remarked that, even if these subsequent notifications had been proper, applicants failed to provide a compliant response within the time periods set by these notifications, which failure also would result in the application being abandoned.

### PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

With regard to item (1) above, applicants have provided a statement that explains that “[t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.” The abandoned status of the application was conveyed to applicants by the Notification of Abandonment mailed on 15 August 2002. Applicants were made aware in this Notification of their continued failure as of 15 August 2002 to satisfy the Sequence Listing requirements as set forth in the Notification of Missing Requirements mailed on 30 April 2001. The rationale provided above for considering the application as correctly having been abandoned results in the same date of and reason for abandonment as set forth in the Notification. Therefore, applicants’ statement satisfies the requirements of 37 CFR 1.137(b)(3) and the requirement of item (1) above.

With regard to item (2) above, applicants filed a paper form Sequence Listing, a CRF Sequence Listing, and statement on 02 December 2002, which CRF Sequence Listing has been deemed technically acceptable, meeting the requirement of item (2) above.

With regard to item (3) above, applicants have furnished the required petition fee of \$1280.00, meeting the requirement of item (3) above.

With regard to item (4), a terminal disclaimer is not required as the application was filed after 08 June 1995, meeting the requirement of item (4) above.

Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

#### CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is GRANTED as to National Stage in the United States of America.

This application has an international filing date of 17 May 1999 under 35 USC 363 and a date of 28 November 2000 under 35 USC 371(c)(1), (c)(2), and (c)(4).

The application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



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